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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,389	10/02/2001	Donald J. Merkley	129843-1022	9683
60148 7590 05/27/2010 GARDERE / JHTL GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER HALPERN, MARK	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 05/27/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/970,389

**Applicant(s)**

MERKLEY ET AL.

**Examiner**

Mark Halpern

**Art Unit**

1791

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25, 28-38, 40-48 and 74-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 28-38, 40-48 and 74-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/C-3)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1) Applicants' election without traverse of invention I, drawn on claims 25, 28-38, 40-48, 74-76, in the reply filed on 3/23/2010, is acknowledged. Claims 68-73 are cancelled.

The amended claims 25, 33, 44-48, and new claims 74-76 originally submitted with an RCE on 12/4/2009 are reviewed at this time.

#### ***Specification***

2) Specification, on Page 7, paragraph [0021], recites three copending applications however the copending application numbers are missing.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3) Claims 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 74 is not clear since the claim starts as a "A composite building material formulation" and in lines 9-12, recites "forming the fiber cement mixture into a fiber cement article of a pre-selected shape and size; and curing the fiber cement article so as to form the fiber reinforced composite building material". The claim is considered

as a formulation and the fiber cement article is considered how the formulation is used, unless the claim is rewritten to recite a process of making a fiber cement article.

Claim 74 recites the limitation "the low COD" in line 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 25, 28-38, 40-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamada (JP 11-10631). Yamada discloses composite building material made up of cement mixed with pulp of cellulosic fiber. The mixture composition is made of 200 g of Portland cement and 20 g of pulp added to water. The pulp is thus 11 % of the mixture of pulp and cement. The Yamada pulp cement mixture Chemical Oxygen Demand (COD) is 5 ppm (0.000,005)

or less, which is lower than the claimed COD of less than 4.5 kg/ton which calculates to 0.00225 (Abstract Pg. 2, whole document Pgs. 3-7). Claims 25 and 33 recite washing at "the elevated temperature...between 65 degrees Centigrade to about 120 degrees Centigrade," The washing at the elevated temperature does not structurally differentiate the material in the product by process claims 25, 28-38, 40-48 over the cited prior art. The source of COD in the Yamada pulp cement mixture is the cellulose fibers. Yamada thus discloses the claimed COD level of the cellulose fibers prior to combining into composite, or in the least, it would have been obvious to one skilled in the art at the time the invention was made, that Yamada discloses the claimed COD level in the cellulose fibers, since the source of COD in the mixture are the cellulose fibers regardless of when the COD content is measured.

In the event any differences can be shown for the product of the product-by-process claims 25, 28-38, 40-48, as opposed to the product taught by the reference Yamada, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

5) Claims 74-75 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamada (JP 11-10631). Yamada discloses composite building material made up of cement mixed with pulp of cellulosic fiber. The mixture composition is made of 200 g of Portland cement and 20 g of pulp added to water. The pulp is thus 11 % of the mixture of pulp and cement. The Yamada pulp cement mixture Chemical Oxygen Demand (COD) is 5 ppm (0.000,005)

or less, which is lower than the claimed COD of less than 4.5 kg/ton which calculates to 0.00225 (Abstract Pg. 2, whole document Pgs. 3-7). The source of COD in the Yamada pulp cement mixture is the cellulose fibers. Yamada thus discloses the claimed COD level of the cellulose fibers prior to combining into composite, or in the least, it would have been obvious to one skilled in the art at the time the invention was made, that Yamada discloses the claimed COD level in the cellulose fibers, since the source of COD in the mixture are the cellulose fibers regardless of when the COD content is measured. The claim 74, lines 9-12, phrase "forming the fiber cement mixture into a fiber cement article of a pre-selected shape and size; and curing the fiber cement article so as to form the fiber reinforced composite building material" is considered how the composite building material formulation is used.

In the event any differences can be shown for the product of the product-by-process claims 74-75, as opposed to the product taught by the reference Yamada, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

6) Claim 76 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamada (JP 11-10631). Yamada discloses composite building material made up of cement mixed with pulp of cellulosic fiber. The mixture composition is made of 200 g of Portland cement and 20 g of pulp added to water. The pulp is thus 11 % of the mixture of pulp and cement. The Yamada pulp cement mixture Chemical Oxygen Demand (COD) is 5 ppm (0.000,005)

or less, which is lower than the claimed COD of less than 4.5 kg/ton which calculates to 0.00225 (Abstract Pg. 2, whole document Pgs. 3-7). The source of COD in the Yamada pulp cement mixture is the cellulose fibers. Yamada thus discloses the claimed COD level of the cellulose fibers prior to combining into composite, or in the least, it would have been obvious to one skilled in the art at the time the invention was made, that Yamada discloses the claimed COD level in the cellulose fibers, since the source of COD in the mixture are the cellulose fibers regardless of when the COD content is measured. The Yamada composite building material in addition to cement and pulp includes solid components, such as an inorganic filler, calcium carbonate or mica, and siliceous material fly ash or ground silica stone (Page 3, lines 1-10). Example (Page 5, lines 5-19) discloses a composition of 40 parts by weight of cement, 40 parts by weight of siliceous material, 6 parts by weight of pulps having 5 ppm or less of the pulp COD and 14 parts by weight of inorganic filler making a 10% by weight of solids content cement composition.

In the event any differences can be shown for the product of the product-by-process claim 76, as opposed to the product taught by the reference Yamada, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

***Response to Amendment***

7) Applicants' arguments filed 12/4/2009 have been fully considered but they are not persuasive.

Applicants allege that the cited prior art, Yamada, does not disclose the invention because Yamada discloses COD measured from the mixture of cement and cellulose fibers and not COD from cellulose fibers alone.

Yamada discloses pulp cement mixture Chemical Oxygen Demand (COD) to be 5 ppm (0.000,005) or less, which is lower than the claimed COD of less than 4.5 kg/ton which calculates to 0.00225. The source of COD in the Yamada pulp cement mixture is the cellulose fibers. Yamada thus discloses the claimed COD level of the cellulose fibers prior to combining into composite, or in the least it would have been obvious to one skilled in the art at the time the invention was made, that Yamada discloses the claimed COD level in the cellulose fibers, since the source of COD in the mixture are the cellulose fibers regardless of when the COD content is measured.

Applicants allege that Yamada does not accurately disclose the COD levels since the COD measurement method is not proper.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the COD measurement method) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



***Conclusion***

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

/Mark Halpern/  
Primary Examiner  
Art Unit 1791

**Serial Number**



**Application No.**

09/970,389

**Applicant(s)**

MERKLEY ET AL.

**Examiner**

Mark Halpern

**Art Unit**

1791